

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed November 19, 2008. Upon entry of this response, claims 1-22 are pending in the application. Applicant respectfully requests reconsideration of all pending claims.

1. Priority Date

Page 2 of the non-final Office action alleges that the application pertaining to the beneficial priority date fails to "support the claimed subject matter such as 'selecting for encryption...using a identifier.'"

Applicants wish to thank Examiner Chai for his attempts at advancing the prosecution of this matter. However, Applicants respectfully disagree with the above allegations of non-support from the non-final Office Action. In addition, in view of the non-final Office Action of November 8, 2007, it appears that the denial of the beneficial priority date is based on 35 U.S.C. §112(1), and hence from page 2 of the non-final Office Action dated November 18, 2008, the effective filing date alleged for the present claims is June 25, 2003.

Further, the Office Action summary referenced and reproduced in part above as made mention of previously filed declarations for other cases. Applicants respectfully note that for the present case, the rejection is improper. That is, for a proper rejection under 35 U.S.C. §112(1), MPEP 2163 provides as follows:

The examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. See *Wertheim*, 541 F.2d at 263, 191 USPQ at 97 ("[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims."). However, when filing an amendment an applicant should show support in the original disclosure for new or amended claims.

Applicants respectfully submit that the present rejection has not met the *initial* burden established under MPEP 2163 for rejecting the priority claim, and hence the rejection is deficient

in that regard. Nevertheless, in the interest of advancing prosecution on the merits, Applicants address where support can be found in the specification for the current claim language. MPEP 2163 provides the following guidelines for 35 U.S.C. §112(1) with respect to priority dates:

To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998).

As the non-final Office Action alleges priority issues with the first and second elements of claim 1, as an illustrative example, Applicants address those elements below in the context of the written description requirement. Claim 1 requires "selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier," and "encrypting the selected digital bit stream according to a first level encryption method to provide an encrypted instance."

Applicants wish to draw attention to page 13, lines 6-16 of the specification, which is used in conjunction with Figure 3. Figure 3 and the above-noted specification portion reveals a digital bit stream (e.g., transport stream) comprising ECM encrypted according to 3DES (e.g., 321) and audio/video/data content coded according to DES (e.g., 327). Such a disclosure would be readily evident to one having ordinary skill in the art that different encryption methods for the same stream, different portions, are contemplated. In addition, page 27 of the specification (lines 19-29), used in conjunction with Figure 7, describes detailed mechanisms of MPEG transport, and in particular, the fact that "any part or all of MPEG transport stream" may be encrypted, revealing to one having ordinary skill in the art that the stream may comprise clear and encrypted portions (i.e., partially encrypted). Note that one encryption method is described as the DES algorithm (for the program), and on page 28, lines 15-22, the ECMs are encrypted according to a different method (3DES), consistent with the previously described portions of the specification pertaining to Figure 3.

Accordingly, it is clear that the specification supports the above-recited claim 1 elements, and to the extent such elements are found in identical or similar form in claim 13, Applicants respectfully request that the priority denial be withdrawn. In addition, since the current application is a continuation along a line of continuations having an effective priority date of July 8, 1998, the effective filing date at least goes back to July 8, 1998. Although Applicants respectfully disagree with the allegations pertaining to the alleged unpersuasiveness of the affidavits in related cases (and hence believe priority can be dated back to the provisional application date of August 1, 1997), the issue of support in the provisional is moot for purposes of the present rejection and the *Candelore* and *Unger* references.

2. Rejection of Claims 1-22 under 35 U.S.C. §102(e)

Claims 1-22 have been rejected under §102(e) as allegedly anticipated by *Candelore et al.* (U.S. 7,376,233, herein, “*Candelore*”) with incorporated by reference *Unger et al.* (“*Unger*,” U.S. Patent Pub. 2003/0026423). Applicants respectfully traverse this rejection. In particular, since the claims of the present application enjoy the benefit of a filing date that predates the effective filing date of *Candelore* (and *Unger*), the art of record does not represent anticipatory subject matter, and accordingly, the rejection should be withdrawn.

For at least the reason that independent claims 1 and 13 are allowable over the cited references of record, respective dependent claims 2-12 and 14-22 are allowable as a matter of law.

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-22 be allowed to issue. Any statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

Date: February 19, 2009

/David Rodack/
David Rodack, Reg. No. 47,034

Merchant & Gould P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903
404.954.5100